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OFFICE OF PETITIONS

In re Asius et al. : DECISION ON REQUEST
Patent No. 7,731,758 : FOR
Issue Date: June 8, 2010 : RECONSIDERATION OF
Application No. 10/809,349 : PATENT TERM ADJUSTMENT
Filed: March 26, 2004 : and
Docket No. 22114-00001-US1 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on August 6, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand seven hundred forty-seven (1747) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand seven hundred forty-seven (1747) days is **GRANTED to the extent indicated herein.**

Patentees assert the total period of adjustment is 1747 days, which is the sum of 651 days of A delay and 499 days of B delay and 634 days C delay, reduced by 37 days of applicants' delay.

The Office concurs with patentees' assertion the period of A delay is 651 days. However, the Office's calculation of the period of A delay differs from patentees' calculation. Patentees argue that the Office should be charged a three (3) day adjustment, pursuant to 37 CFR 1.702(a)(3), for delay in mailing a Notice of Allowance on January 26, 2010, after the Board of Patent Appeals and Interferences (BPAI) mailed a decision on September 23, 2009 reversing the examiner.

37 CFR 1.705(d), provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

A patentee is not permitted to raise an issue that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b) in a petition under 37 CFR 1.705(d). If applicants did not agree with the lack of adjustment in connection with the mailing of the January 26, 2010 Notice of Allowance, the appropriate time to contest it would have been after the Notice of Allowance was mailed and prior to payment of the issue fee. The issue is untimely raised in a petition under 37 CFR 1.705(d) and will not be addressed.

The period of A delay is 651 days because the Office mailed a non-final Office action on March 8, 2007, 14 months and 651 days after the application was filed on March 26, 2004 (37 CFR 1.702(a)(1)).

The Office does not concur with patentees' assertion the period of B delay is 499 days. The Office concurs with patentees' assertion that the maximum B delay period begins on March 27, 2007, which is one day after three years after the filing of the application on March 26, 2004, and ends on June 8, 2010, when the patent issued.

As stated in 35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." The period of B delay does not include the 636 (not 634, as patentees' assert) day period beginning on December 28, 2007, the date the Notice of Appeal was filed, and ending on September 23, 2009, the date the Board of Patent Appeals and Interferences issued a decision reversing the examiner.

Applicant delay is not factored into the B delay equation.

Excluding the 636 days consumed by appellate review results in a period of B delay of 534 days (1170 - 636).

Although the 636 days consumed by appellate review is not part of the period of B delay, the 636 days does constitute delay under 35 U.S.C. 154(b)(1)(C) ("C delay"). In other words, the successful appellate period of 636 days is counted against the Office as a separate adjustment pursuant to 37 CFR 1.702(e) as C delay.

The Office concurs with Patentees' calculation of Applicant delay under 35 U.S.C. 154(b)(2)(C) as 37 days.

Patentees assert the total patent term adjustment is 1747 days. However, the patent term adjustment is 1784 days, which is the sum of 651 days of A delay and 534 days of B delay and 636 days of C delay reduced by 37 days of Applicant delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand seven hundred eighty-four (1784) days**.

Telephone inquiries should be directed to the undersigned at
(571) 272-3230.

Shirene Willis Brantley
Shirene Willis-Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,731,758 B2

DATED : June 8, 2010

DRAFT

INVENTOR(S) : Asius et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1651 days

Delete the phrase "by 1651 days" and insert – by 1784 days--